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PAPER

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The time period for reply, if any, is set in the attached communication.

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUHIKO OGURA

Appeal 2008-2454
Application 09/373,585
Technology Center 1600

Oral Hearing Held: June 10, 2008

Before TONI R. SCHEINER, DEMETRA J. MILLS, and LORA M.
GREEN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

Ruthleen Uy, Esquire
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P R O C E E D I N G S

MS. BOBO-ALLEN: Calendar Number 7, Appeal Number 2008-
2454. Ms. Uy.
JUDGE SCHEINER: Thank you.

1 MS. BOBO-ALLEN: You're welcome.

2 JUDGE SCHEINER: Good morning.

3 MS. UY: Morning. Morning, Your Honor. My name is Ruthleen Uy
4 and I represent the Appellant Nobuhiko Ogura with respect to Appeal
5 Number 2008-2454.

6 JUDGE SCHEINER: Um-hum.

7 MS. UY: The Appellant's invention is directed to an apparatus for
8 manufacturing a test piece. Claims 6, 7, and 21 to 33 are pending in the
9 present application and are on appeal. I will be specifically discussing the
10 rejection of Independent Claim 26 and 6 as discussed in the Appellant's
11 appeal brief.

12 JUDGE SCHEINER: Okay.

13 MS. UY: Claim 26 has been rejected as being anticipated by the
14 Stimpson Reference. It is the Appellant's position that Stimpson does not
15 anticipate Claim 26 for at least the following reasons. First, Stimpson does
16 not disclose the claim strip-like substrate bearing thereon numbers of known
17 specific binding agents. Second, Stimpson does not disclose an applicator
18 mean arranged at predetermined intervals in a first direction relative to a
19 sheet-like substrate. Third, Stimpson does not teach a cutting means which
20 cuts the sheet-like substrate bearing thereon the plurality of specific binding
21 agents in a first direction into a plurality of strips. And fourth, the examiner
22 has improperly construed the claimed applicator means, conveyer means,
23 and cutting means and their corresponding functions.

24 So with respect to the first argument, it is the Appellant's position that
25 Stimpson does not disclose a strip-like substrate bearing thereon numbers of

1 known specific binding agents arranged in a line at predetermined intervals
2 and at a longitudinal direction of the strip-like substrate. Now, the examiner
3 had indicated that this language of the claims was merely intended use
4 because it was in the preamble of the claim. However, it's the Appellant's
5 position that during examination statements in the preamble reciting the
6 purpose or intended use of the claimed invention must be evaluated to
7 determine whether the recited purpose or intended use results in a structural
8 difference between the claimed invention and the prior art.

9 JUDGE SCHEINER: Again, now we are talking about the apparatus,
10 so why don't we talk about structural differences that are specific to the
11 apparatus and not to the resulting strip?

12 MS. UY: Okay.

13 JUDGE SCHEINER: Okay.

14 MS. UY: Sure. But I would just also like to continue to assert that
15 the preamble should be construed because it does give structure to the
16 claims. For example, Claim 26 in the preamble, it does refer to the test piece
17 for use in biological analysis of a sample organism comprising a strip-like
18 substrate bearing thereon numbers of known specific binding agents. And as
19 you see, the language in the preamble is referred to later on in the body of
20 the claim. Therefore, it's Appellant's position that language in the preamble
21 does limit the structure of the invention, for without the preamble of the
22 claim you would not be able to understand the remaining language of the
23 claims.

24 Okay, the second aspect of the Applicant's -- with respect to that first
25 aspect of the argument, it is Appellant's position that Stimpson does not

1 disclose aspect of the invention because Stimpson does not disclose applying
2 regent in a direction as claimed. In Stimpson the regent is applied in a
3 direction perpendicular to a longitudinal direction of a sheet.

4 JUDGE SCHEINER: Okay. Is Stimpson's -- is there any evidence
5 that Stimpson applicators would be capable of --

6 MS. UY: There's no indication as to how it's applied.

7 JUDGE SCHEINER: Okay.

8 MS. UY: And the aspect of Stimpson the examiner referred to was on
9 Column 8 in which he referred to this AsymtekAsemtech (phonetic sp.)
10 Reference but there's no indication as to the relation of a sheet with the
11 dispenser.

12 JUDGE SCHEINER: Okay.

13 MS. UY: All it discloses is that there's a dispenser and there's a
14 sheet.

15 JUDGE SCHEINER: Okay.

16 MS. UY: Okay. The second aspect of the Applicant's argument is
17 that Stimpson does not disclose the claimed applicator means arranged at
18 predetermined intervals in a first direction relative to a sheet-like substrate,
19 and so the examiner indicated basically what you're referring to, that the
20 XYZ Table that's discussed in Column 8, Lines 32 to 49, disclose the claim
21 applicator means, but it was Applicant's position that the applicator means is
22 arranged at predetermined intervals in a first direction relative to a sheet-like
23 substrate, and there's no indication regarding the arrangement of the
24 applicator of Stimpson. The third aspect of Appellant's argument was that
25 Stimpson does not disclose the claim cutting means. In particular, in

1 Stimpson, cutting is performed after a sheet is rolled into a rod shape.
2 Therefore, the cutting performed in Stimpson does not cut a sheet like
3 substrate as claimed. And in addition, there's no indication that the razor of
4 Stimpson cuts a sheet-like substrate into a plurality of strips. As you see in
5 Figure 1B of Stimpson, there is no disclosure of cutting into a plurality of
6 strips because it's cutting a rod bundle. And in addition, it is Appellant's
7 position that the cutting device of Stimpson which cuts the rod bundle is not
8 analogous of the Applicant's claimed cutting means. Specifically referring
9 to A.J. Deere (phonetic sp.) Company, in which the Court indicated that a
10 defendant's saw mill was not analogous to the plaintiff's meat cutting device
11 because the saw mill was used for cutting logs which are generally of a large
12 dimension, both in length and diameter, and are basically a different
13 substance to cut from the Appellant's -- the plaintiff's cutting device.

14 So, therefore, it is the Appellant's position that the razor of Stimpson
15 which is used to cut a sheet which is rolled into a rod shape would not be
16 used -- would not necessarily be used to teach the claimed cutting means
17 which cuts sheet-like substrate which is flat.

18 JUDGE SCHEINER: You're saying that it couldn't be?

19 MS. UY: It would not necessarily. So it would not merely because
20 there is disclosed a cutting means does not mean you would be capable of
21 cutting the same type of shape, thickness or dimension.

22 JUDGE SCHEINER: Is there a difference in the direction of cut?

23 MS. UY: The cutting means --

24 JUDGE SCHEINER: The apparatus?

25

1 MS. UY: Well, I'm -- I just -- because ours cuts into a plurality of
2 strips, so the cutting means would obviously have to be able to take a sheet
3 and cut it into strips as opposed to the Stimpson Reference as capable of
4 taking a log and cutting it into a circular arrays. So, therefore, clearly just
5 based on shape, I would assume that they would not be able to cut the same -
6 - you would not be able to take the cutting device of Stimpson and
7 necessarily cut --

8 JUDGE SCHEINER: Well, I don't see --

9 MS. UY: -- something else.

10 JUDGE SCHEINER: I don't see how you can make that assumption
11 without evidence. But, what I'm asking you is whether or not your
12 apparatus cuts in a -- according to the claim, the cutting means cuts in the
13 first direction. Does Stimpson do the same thing or does Stimpson's
14 cutting --

15 MS. UY: Stimpson --

16 JUDGE SCHEINER: -- parallel to --

17 MS. UY: Stimpson is cutting in -- versus Stimpson is cutting the
18 log -- I'm not -- it's not really, it's not the same at all because Stimpson does
19 not cut a sheet. Basically, Stimpson cuts a log into circular rays, so
20 Stimpson is not at all similar to our invention in which we're taking a sheet
21 and cutting it because a sheet of Stimpson is then rolled up into a log and at
22 no point is the sheet of Stimpson cut as a sheet. It's rolled and cut as a log
23 as opposed to our invention, the arrays along the sheet are cut as a sheet in
24 order to create strips.

25

1 JUDGE SCHEINER: No, we understand that, but that's a method.
2 We're talking about the apparatus and what it is capable of doing.

3 MS. UY: Correct, but since this contains means language, it's
4 assumed that the functional language not necessarily the method language as
5 you're saying, but the functional language which should be given
6 consideration for the functional aspects with respect to the claimed means.
7 So, therefore, it's the Appellant's position that the functions regarding -- the
8 functional language in relation to the structural components such as the strip
9 should be given consideration.

10 JUDGE GREEN: I think what Judge Scheiner was trying to get to is
11 that in your apparatus, at least looking at Claim 6, that you're cutting in the
12 same direction in which your known specific binding regents. That's your
13 first direction, right?

14 MS. UY: Um-hum.

15 JUDGE GREEN: And then you have a second direction which is
16 perpendicular, which the conveyor conveys along, right?

17 MS. UY: Correct.

18 JUDGE GREEN: So isn't Stimpson cutting this way rather than this
19 way?

20 MS. UY: So --

21 JUDGE GREEN: So that's how you're getting your jelly roll or your
22 log? It's cutting along the longitudinal rather than the horizontal?

23 MS. UY: Let me just --

24 JUDGE GREEN: Because it's the horizontal that gives you the strips,
25 correct?

1 MS. UY: Okay, I'm sorry. Let me just refer to Applicant's figure for
2 comparison, Applicant's Figure 3.

3 JUDGE GREEN: Right. So here you're getting something horizontal
4 to the direction at which the conveyor is going.

5 MS. UY: Okay, so for example, to parallel to Figure 3 the examiner
6 cited Figure 2A which was -- which were the -- which was the sheet to
7 parallel a sheet of Applicant's invention. So the array wouldn't -- I mean I
8 see what you're saying, but it's not cut in the same way in that the cutting
9 device would not end up cutting it the same way.

10 JUDGE SCHEINER: If you look at Figure 2C of Stimpson, okay, so
11 here we're -- they kind of combines all the -- your device is, it sounds like, is
12 cutting along the C axis whereas --

13 MS. UY: It's cutting -- yeah.

14 JUDGE SCHEINER: Where -- so you're getting the strips, right?

15 MS. UY: Correct.

16 JUDGE SCHEINER: So it's kind of along the axis, whereas
17 Stimpson is cutting along the Y axis so that you get your jelly roll. So
18 Stimpson is cutting in the direction that the conveyor is going. That's how
19 you get your rolled up array.

20 MS. UY: I have no idea what direction it's being conveyed at. I
21 don't see any conveyor rolled.

22 JUDGE SCHEINER: Well, if we assume that it's being conveyed
23 along Y, I mean that's --

24 MS. UY: Okay, I mean there's no indication --

25 JUDGE SCHEINER: -- the direction that the sheet is moving.

1 MS. UY: -- as to when it's conveyed because it, it says a roll.

2 JUDGE SCHEINER: Okay.

3 MS. UY: You know what I'm saying like as a sheet, there -- I can't
4 see how --

5 JUDGE SCHEINER: Okay, why don't we just move along.

6 MS. UY: Yeah, so basically I don't see how there's the conveyance
7 of the roll of 2C.

8 JUDGE MILLS: Didn't you claim mention a sheet-like substrate.
9 Isn't a rolled substrate still a sheet? Have you defined sheet-like in the spec
10 or why should --

11 MS. UY: I don't believe that would have -- we never -- I don't
12 believe that was an issue based on our Figures and I believe we were with
13 agreement with the Examiner as to what constituted a sheet because he
14 would -- he didn't cite the roll as a sheet. He cited the Figure 2A as a sheet,
15 so I didn't believe there was an issue with interpreting what a sheet was
16 based on Applicant's Figure 3.

17 Okay, and the fourth aspect of Applicant's position with respect to
18 Claims 26 and with respect to Claim 26, is that the examiner has improperly
19 construed the claimed applicator means, conveyor means and cutting means
20 and the corresponding functions. The examiner had indicated that the
21 specification does not define an applicator means, conveyor means or cutting
22 means. Therefore, the examiner indicated that since the specification didn't
23 define this aspect the claim -- that the examiner reasoned that any element of
24 Stimpson cited by the examiner can be used to teach the claimed element
25 and its corresponding function.

1 He also cited MPEP 2182, but it's Appellant's position that according
2 to MPEP 2182 when constructing means plus function claims the first step is
3 to define the particular function of claim limitation, and then the Court must
4 construe the function of the means plus limitations to include limitations
5 contained in the claim language. So it's the Appellant's position that the
6 examiner has not construed the claim applicator means, conveyor means,
7 and cutting means according to the claim limitations because the examiner
8 basically chose to disregard the functional language of the claim and
9 basically cited any aspect of the Stimpson Reference for teaching the claim
10 means when they were clearly not consistent with the functional language in
11 relation to the structure.

12 And the second aspect of MPP2182 is that construing a means plus
13 function claim limitation, you must look to the specification in identifying
14 the core and structure, the corresponding structure for that function.

15 JUDGE SCHEINER: Just out of curiosity, where is that for the
16 cutting means in the specification?

17 MS. UY: It's on Page 17 of the Applicant's specification and is
18 illustrated in Figure 3, Cutter Edge 61, Guide rail 60. It was also
19 summarized in the summary of the claimed subject matter in the appeal
20 brief.

21 And so in looking at the specification and the figures, it is clear that
22 the aspects of Stimpson cited by the examiner are not consistent with the
23 interpretation of the claim means as disclosed in the Applicant's --
24 Appellant's specification.

25

1 So, therefore, it's Appellant's position that the examiner improperly
2 construed the means plus function that corresponds to any element in the
3 Stimpson Reference without taking into account the functional language of
4 the claim. And although Claim 6 does not necessarily contain the same
5 means plus language, it's Appellant's position that functional language
6 should be given due consideration consistent with MPEP 2173.05g,
7 especially since Appellant requested that such language be given
8 consideration.

9 I'll go on now to Claim -- the rejection of Claims 23 and 24 as being
10 unpatentable over Stimpson in view of Shuminov. It's the Appellant's
11 position that the combination of Stimpson and Shuminov did not teach the
12 elements of Claims 23 and 24 since Shuminov is nonanalogous art to
13 Stimpson and therefore would not be combined.

14 In performing the analysis for nonanalogous art, a reference is -- you
15 have to determine if a reference is reasonably pertinent even though it may
16 be in a different field from the inventor's endeavor. It is one which because
17 of the matter in which it deals logically with the commended itself to an
18 inventor's attention. So, in order for reference -- in order to rely on a
19 reference as a basis for rejection, the examiner must either be in the field of
20 Applicant's endeavor or reasonably pertinent to the particular problem to be
21 solved.

22 In the present case, both standards -- both prongs have not been met.
23 Stimpson is directed to parallel production of high density arrays and
24 Shuminov is directed to moisture detecting liner for a diaper and a process
25 for the manufacture thereof. Therefore, based on the titles alone you can see

1 that they're directed to totally different fields of array, array creation and
2 development as opposed to diaper moisture detection.

3 So in addition, they're not reasonably pertinent to the problem to be
4 solved because as I just indicated, Stimpson is directed to producing arrays
5 of compounds for concurrent testing, which arrays can be mass produced as
6 opposed to Schumenoff is directed to determining short circuiting of a track
7 in a diaper liner so as to alert a user of moisture in a diaper. So, therefore,
8 it's the Appellant's position that Stimpson is not reasonably pertinent to the
9 problem and Shuminov is not reasonably pertinent to the problem solved by
10 Stimpson.

11 In addition, Appellant submits that Shuminov is not functionally or
12 structurally similar. So functionally, Schumenoff is directed to moisture
13 sensing pads for sensing moisture and such pads are used in disposable
14 diapers, the purpose being to detect wetness. So, therefore, Shuminov, which
15 is directed to determining wetness, is not reasonably pertinent to the
16 manufacturer of a test piece for DNA analysis. Specifically, it is unlikely
17 that an inventor would look to a process for creating diapers for teaching a
18 strip-like substrate containing binding agents.

19 And structurally, Shuminov's diaper assembly would not be
20 reasonably pertinent to the precision required in substrate assembly for DNA
21 sequence analysis. The examiner appears to assert that the reason why he
22 could cite the Shuminov Reference is because both Shuminov and Stimpson
23 -- I mean because they're both directed to a conveyor. So it's Appellant's
24 position that based on the factors discussed above, it's clearly not analogous
25 and referent and relevant and is clearly directed to a different field of

1 endeavor, regardless of that their conveyor is disclosed in both references, in
2 both inventions.

3 JUDGE SCHEINER: Well, why don't we move on to the last
4 rejection?

5 MS. UY: Okay, the rejection of Claim 30 in view of Stimpson,
6 Shuminov and Beeterman (phonetic sp.), the examiner had indicated that
7 Beeterman teaches a guide rail located on an upper body portion of a cutting
8 means. Therefore, he cited that the combination would be obvious. The
9 examiner has cited Shuminov Guide-rail 50 for teaching the claimed guard-
10 rail and then he cited the razor of Stimpson for teaching the claimed cutting
11 means, And it was discussed in Stimpson that the roll -- the tube was going
12 to be placed in -- the rod bundle was to be placed in the metal tube and a
13 razor would then cut it, and the metal tube was used as a guide to cut the
14 circular bundle array.

15 So, therefore, it's Appellant's position that it wouldn't be
16 obvious to modify the system of Stimpson which clearly teaches its own
17 method of cutting a rod bundle. So, therefore, it wouldn't be obvious to
18 modify it when it already teaches a way of cutting and supposedly creating
19 aligned arrays from the rod bundle. So, basically, it's -- that's Appellant's
20 position, that since it already obtains its desired result it wouldn't be obvious
21 to modify it and clearly is a result of hindsight.

22 So for all these reasons, Appellant believes that Claims 6 and 26
23 should be allowable.

24 JUDGE SCHEINER: Thank you.

25

1 (Whereupon, the proceedings concluded at 10:20 a.m.
2 on June 10, 2008.)

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